

PATENT
Application 10/748,959
Attorney Docket 2003-0009 (1014-053)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1, 2, and 16-20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Support for the amendments to each of claims 1, 19, and 20 can be found in the application as originally submitted at least at paragraph 49. Support for the amendments to claim 2 can be found in the application as originally submitted at least at paragraph 53. It is respectfully submitted that no new matter has been added.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

I. The Response to Arguments Section

In a section entitled "Response to Arguments", the present Office Action asserts, at Page 10:

Note: It has been held that the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

With all due respect, *In re Hutchison* was decided 20 years prior to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and thus, could not have used the obviousness criteria established by *Graham*. In over 60 years since *In re Hutchison* was decided, no appellate court has cited *In re Hutchison* as authority for a premise that "an element 'adapted to' perform[]

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a function is not a positive limitation in any patentable sense but only requires the ability to perform", as asserted by the present Office Action. For at least these reasons, *In re Hutchison* is no longer valid law in view of *Graham* and subsequent case law regarding the claim phrase "adapted".

The predecessor court to the Federal Circuit has interpreted the phrase "adapted" as preceding a "structural limitation". See, *In re Venezia*, 530 F.2d 956 (CCPA 1976). Claim limitations preceded by "adapted" have been considered sufficiently definite. See MPEP 2173.05(g).

In addition, the Federal Circuit has interpreted the word "adapted" as preceding "functional language [that] limits the scope of these claims to devices that have the capability of" performing the stated function. See, *R.A.C.C. Indus., Inc. v. Stun-Tech, Inc.*, 178 F.3d 1309, 49 USPQ2d 1793 (Fed. Cir. 1998) (*cert. denied*, 526 U.S. 1098 (1999)) (cited with approval by MPEP 2106.IV.B). Because such functional language serves as a claim limitation, a reference cited to support a rejection of a claim must describe a structure(s) capable of performing each claimed function preceded by the term "adapted."

Further, in the case of *In re Land*, the CCPA ruled on a relevant claim that stated "said color-providing substances associated with at least the inner photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive ... layer has occurred." See, *In re Land*, 368 F.2d 866, 151 USPQ 621, 635 (CCPA 1966). The CCPA noted that the italicized portions of the claim were functional and held the claim patentable in view of the **functional limitations**.

For at least these reasons, a withdrawal of the assertions regarding claim limitations preceded by the phrase "adapted to", and examination of those claim limitations consistent with valid law, is respectfully requested.

II. The Written Description Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement, and thus was asserted to be unpatentable. These rejections are respectfully traversed as moot in view of the present amendments to each of independent claims 1, 19, and 20.

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Specifically, the present Office Action alleges, at Page 2, “[t]he added subject matter which is not adequately described in the original disclosure is as follow: ‘running said Dolby Digital AC-3 codec on a digital signal processor installed on the subscriber interface line card’.”

As amended, each of independent claims 1 and 20 states, *inter alia*, “running said Dolby Digital AC-3 codec on a signal processor installed on the electronic loop provisioning line card”. Claim 19 states, *inter alia*, “the Dolby Digital AC-3 codec adapted to run on a signal processor coupled to the POTS subscriber loop circuit interface”. Support for this claimed subject matter can be found in the application as originally submitted at least at paragraph 54, which states (emphasis added):

the ELP’s signal processor, and/or the **instructions running on the ELP’s signal processor** can be replaced, substituted, and/or upgraded with a higher bandwidth codec and/or a high quality voice codec such as a 7 kHz ITU-T G.722 codec, and/or a multi-channel codec, e.g., **a Dolby Digital codec**, and/or a DTS codec.

Further, paragraph 49 states regarding “the ELP’s signal processor” (emphasis added), “[t]he ELP’s **signal processor**, which can comprise instructions running on a **digital signal processor** (DSP) chip, can be responsible for encoding the PCM samples from the subscriber into an advantageously compressed format”. In addition, paragraph 70 states (emphasis added), “**the codec instructions can be high-quality audio codec instructions** that are compatible with protocols such as the ITU G series (e.g., G.722, G.723, G.728, G.729, etc.), **Dolby Digital AC-3**, DTS, etc.”

For at least these reasons, Applicant respectfully requests a withdrawal of each rejection of each of claims 1-20.

III. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of WIPO Publication WO/01/17219 (“Hjartarson”), a paper entitled “An Independent Evaluation of the Performance of the CCITT G.722 Wideband Coding Recommendation” (“Smyth”), a paper entitled “Design and Implementation of AC-3 Coders” (“Vernon”), a paper entitled “Session Initiation Protocol (SIP)-H.323 Interworking Requirements” (“Schulzrinne”), U.S. Patent 6,381,238 (“Hluchyj”), U.S. Patent 7,164,694

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("Nodoushani"), and/or U.S. Patent Application Publication 2005/0041603 ("Tighe"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. "Inventions usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known" (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. "Granting patent protection to advances that **would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility" (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art". Thus, in determining obviousness, both *KSR* and *Graham* warned against a "temptation to read into the prior art the teachings of the invention in issue" and instruct to "'guard against slipping into the use of hindsight'".

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KSR further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”. The Federal Circuit has held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “would convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358 (Fed. Cir. 2008).

To guard against hindsight, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “a reason that would have prompted a person of ordinary skill”, *KSR* further taught that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”: *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

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1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id*.

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. The Applied Reference(s) Must Be Enabling

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Rockwell Int'l Corp. v. U.S.*, 147

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F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

4. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. All Claims

The rejection of each of claims 1-20 are traversed as moot in view of the present amendments to each of claims 1, 2, 19, and 20.

Specifically, each of independent claims 1, 19, and 20, from one of which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “the subscriber line interface card chipset adapted to handoff pulse code modulated samples to a digital signal processing chip of the electronic loop provisioning line card, the digital signal processing chip adapted to encode the pulse code modulated samples into a compressed format, the compressed format a low delay code excited linear prediction format, the digital signal processing chip adapted to expand encoded samples from a packet network and delivering samples to the subscriber line interface card chipset, the subscriber line interface card chipset adapted to convert the delivered samples

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to an analog format”.

In addition, claim 2 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “the digital signal processing chip of the subscriber line interface card adapted to encode Voice over ATM and Voice over IP”.

For at least these reasons, reconsideration and withdrawal of each rejection of each of claims 1, 2, 19, and 20 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-18, each of which ultimately depends from independent claim 1, is also respectfully requested.

2. Claims 1-18

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Improper Claim Grouping

By rejecting claims 1, 19, and 20 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 1 states “automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In addition, unlike the other claims in the rejected group, claim 1 states “responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3 signal, automatically substituting a Dolby Digital AC-3 codec for the G.722 codec”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3 signal,

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automatically substituting a Dolby Digital AC-3 codec for the G.722 codec”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

Moreover, unlike the other claims in the rejected group, claim 1 states “encoding the plurality of digital samples via said Dolby Digital AC-3 codec”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “encoding the plurality of digital samples via said Dolby Digital AC-3 codec”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

c. Missing Claim Limitations

Claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, the **“line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722 as a default codec”**. The present Office Action fails to even mention at least the words “default codec” in claim 1 thereby failing to meet the requirements of MPEP 2143.03.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-

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upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, and Tighe, that are used in rejecting claim 1, in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered combination of the applied portions of Hjartarson, Smyth, and Tighe, the present Office Action states, at pages 4-5:

- i. “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25) of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals”; and
- ii. “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the method of negotiating media capabilities as taught by Tighe, into the method taught by Hjartarson for the purpose of providing the best quality of communication as it can be supported by the system”; and

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”. Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 1 cannot be sustained based upon the mere conclusory statements of the present Office Action.

e. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-18, each of which ultimately depends from independent claim 1, is also respectfully requested.

3. Claim 7

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 7 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "via instructions running on the digital signal processor, performing echo suppression on the encoded plurality of digital samples, the line card adapted to switch automatically between the codec specified in G.722 and a POTS codec based upon capabilities of customer premises equipment". No evidence is of record that the applied portions of the relied-upon references used in rejecting claim 7 teach any "line card adapted to switch automatically between" any codecs whatsoever.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

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4. Claim 8

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 8 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “the line card adapted to switch automatically between the codec specified in G.722 and a POTS codec based upon network capabilities”. No evidence is of record that the applied portions of the relied-upon references used in rejecting claim 8 teach any “line card adapted to switch automatically between” any codecs whatsoever.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

5. Claim 15

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

By rejecting claims 6, 7, and 15 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 15 states “via instructions running on the digital signal processor, **suppressing comfort noise samples**

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associated with the analog signal". The common rejection of claims 6, 7, and 15 as a group makes no mention of "via instructions running on the digital signal processor, **suppressing comfort noise samples** associated with the analog signal", and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 15 is respectfully requested.

6. Claim 16

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 16 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the electronic loop provisioning line card adapted to receive a signal indicative of a highest possible bearer bandwidth and codec that a network is capable of supporting, **said Dolby Digital AC-3 codec selected based upon said signal indicative of said highest possible bearer bandwidth and codec**". The present Office Action fails to even mention "**said Dolby Digital AC-3 codec selected based upon said signal indicative of said highest possible bearer bandwidth and codec**" and fails to provide evidence that at least this subject matter is taught by the applied portions of the relied-upon references.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 16 is

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respectfully requested.

7. Claim 19

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Improper Claim Grouping

By rejecting claims 1, 19, and 20 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should never be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 19 states “the line card adapted to receive a signal that customer premises equipment accommodates a Dolby Digital AC-3 signal”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “the line card adapted to receive a signal that customer premises equipment accommodates a Dolby Digital AC-3 signal”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In addition, unlike the other claims in the rejected group, claim 19 states “the Dolby Digital AC-3 codec stored on the electronic loop provisioning line card”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “the Dolby Digital AC-3 codec stored on the electronic loop provisioning line card”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

Moreover, unlike the other claims in the rejected group, claim 19 states “the Dolby Digital AC-3 codec adapted to encode the plurality of digital samples”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “the Dolby Digital AC-3 codec adapted to encode the plurality of digital samples”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

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In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, and Tighe, that are used in rejecting claim 19, in such a manner so as to arrive at the claimed subject matter of claim 19. Regarding the proffered combination of the applied portions of Hjartarson, Smyth, and Tighe, the present Office Action states, at pages 4-5:

- i. “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25) of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals”; and
- ii. “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the method of negotiating media capabilities as taught by Tighe, into the method taught by Hjartarson for the purpose of providing the best quality of communication as it can be supported by the system”; and

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”. Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the

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present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 19 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 19 is respectfully requested.

8. Claim 20

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Improper Claim Grouping

By rejecting claims 1, 19, and 20 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 20 states “automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal”. The common rejection of claims 1, 19, and 20 as a group makes no mention of “automatically determining that customer premises equipment accommodates a Dolby Digital AC-3 signal”, and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In addition, unlike the other claims in the rejected group, claim 20 states “responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3

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signal, automatically substituting a Dolby Digital AC-3 codec for the G.722 codec". The common rejection of claims 1, 19, and 20 as a group makes no mention of "responsive to said determination that customer premises equipment accommodates said Dolby Digital AC-3 signal, automatically substituting a Dolby Digital AC-3 codec for the G.722 codec", and fails to point out where, in any of the references, that claimed subject matter is disclosed.

Moreover, unlike the other claims in the rejected group, claim 20 states "encoding the plurality of digital samples via said Dolby Digital AC-3 codec". The common rejection of claims 1, 19, and 20 as a group makes no mention of "encoding the plurality of digital samples via said Dolby Digital AC-3 codec", and fails to point out where, in any of the references, that claimed subject matter is disclosed.

In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson, Smyth, and Tighe, that are used in rejecting claim 20, in such a manner so as to arrive at the claimed subject matter of claim 20. Regarding the proffered combination of the applied portions of Hjartarson, Smyth, and Tighe, the present Office Action states, at pages 4-5:

- i. "[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the G.722 codec and AC-3 codec, as taught by Smyth and Vernon, into the line card (specifically 24 or 46, Hjartarson: page 9, lines 21-25) of Hjartarson for the purpose of providing high quality voice signals and enhancing the performance of the transmitted signals"; and
- ii. "[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to use the method of negotiating media capabilities as taught by Tighe, into the method taught by Hjartarson for the purpose of

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providing the best quality of communication as it can be supported by the system"; and

The present Office Action presents no evidence that the proffered combination of elements, selected by the Office from the applied portions of the relied-upon references to arrive at the claimed subject matter are "a finite, and in the context of the art, small or easily traversed, number of options" that "would convince an ordinarily skilled artisan of obviousness". Moreover, the present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 20 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 20 is respectfully requested.

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CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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